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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,086	07/21/2003	Arthur Ho	D-2895CIP2	6002
33197	7590	03/01/2006	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP			SCHWARTZ, JORDAN MARC	
4 VENTURE, SUITE 300			ART UNIT	
IRVINE, CA 92618			PAPER NUMBER	
			2873	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/624,086

Applicant(s)

HO ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21, 23, 25-29, 31-42 and 44-51 is/are rejected.
- 7) ☒ Claim(s) 10, 22, 30 and 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 25, 44, 46, 48, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 25 is dependent from claim 24, which has been cancelled. The intended dependency of claim 25 is not known rendering the claim vague and indefinite. For purposes of examination it is presumed that claim 25 now depends from claim 23.

Specifically in reference to claims 44, 46, 48, and 50 applicant is claiming "extended wear" but it is not clear as to what length of wear the contact lens would be required to be worn in order to be considered "extended wear" and the lack of clarity renders the claims vague and indefinite. Furthermore, any contact lens could be worn for long periods of time although such lenses would provide discomfort etc so any contact lens could inherently provide "extended wear".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-21, 23, 25-29, 31-42, 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman et al patent number 5,880,809 in view of Kunzler et al patent number 6,921,802.

With reference to claims 1-4, 7-9, 11-12, 15, 17-21, 24-25, 31-41, Lieberman discloses the limitations therein including the following: a contact lens (abstract) comprising a lens body including a soft hydrophilic or hydrogel material (column 15, lines 52-62); one of the anterior or posterior surface as a substantially smooth junctionless (Figures 8-9, column 11, lines 34-66); three dimensional asymmetrical surface (column 3, line 32 to column 4, line 11, column 11, lines 34-66); a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness (column 11, lines 34 to column 12, line 8 re substantially junctionless and Figures 8-9 which disclose the thickness of the lens varying radially and column 12, lines 1-7 re the peripheral portion shaped in the form of an S-curve which will cause the thickness of the peripheral portion to vary radially); and the varied surface topography facilitating lens comfort (column 12, lines 1-7). Lieberman discloses as is set forth above including that the lens material can be a soft hydrophilic or hydrogel material (column 15, lines 52-62) but does not specifically disclose this material as a silicone hydrogel or hydrophilic silicone polymer and does not specifically disclose the lens formed by cast-molding. Kunzler et al teaches that contact lenses made of soft hydrophilic or hydrogel material (column 1, lines 10-37, column 3, line 60) can specifically be formed by cast-molding of silicone hydrogel or hydrophilic silicone polymer for the purpose of making a contact lens of improved oxygen permeability and

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improved comfort (column 1, lines 10-37, column 3, line 60, column 8, lines 22-45).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the soft hydrophilic or hydrogel contact lens of Lieberman as being specifically made by cast-molding a silicone hydrogel or hydrophilic silicone polymer since Kunzler et al teaches that contact lenses made of soft hydrophilic or hydrogel material can specifically be made by cast-molding a silicone hydrogel or hydrophilic silicone polymer for the purpose of providing a contact lens of improved oxygen permeability and improved comfort. Lieberman further discloses the posterior and/or anterior surface as the substantially junctionless three dimensional surface (column 5, line 1 to column 8, line 52). Furthermore, with respect to the anterior surface, Lieberman et al discloses that the anterior surface can be a blended toric surface (column 10, lines 15-32). A toric surface will inherently be three dimensionally asymmetrical and a blended surface will inherently be smooth. Lieberman et al further discloses the lens body including a toric surface to correct an astigmatism (column 2, line 53, column 10, line 18); the posterior surface to approximate the curvature of the cornea (column 14, line 62); and the lens including a multifocal optical zone (column 15, line 33). The lens of Lieberman et al will inherently maintain a uniform distance between the corneal surface and the lens, this being reasonably based upon the similarity in structure between the lens of Lieberman et al and that of the claimed invention.

With reference to claims 5-6, 16, 23, 26-29, 35, and 42, Lieberman and Kunzler et al disclose and teach as set forth above but do not specifically disclose the lens including a ballast by a varied anterior and/or posterior surface. However, the examiner

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takes Judicial Notice that it is well known in the art of contact lenses for such lenses to have a varied anterior and/or posterior surface defining a ballast for the purpose of providing improved lens stability on the eye. Furthermore, Lieberman teaches that contact lenses can comprise a ballast for the purpose of providing increased lens stability (column 15, lines 8-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Lieberman et al as modified by Kunzler et al as having a varied anterior and/or posterior surface defining a ballast since such a structure is well known in the art of contact lenses and is further taught by Lieberman with respect to prior art lenses for the purpose of providing a lens of improved stability on the eye.

With reference to claims 13-14, Lieberman and Kunzler et al disclose and teach as is set forth above and Kunzler further teaches that the hydrophilic silicone polymer can further include at least one monomer of siloxane for the purpose of providing a contact lens of improved oxygen permeability and comfort (column 1, lines 10-37, column 3, line 65 to column 4, line 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the hydrophilic silicone polymer as including at least one monomer of siloxane since Kunzler et al further teaches of this feature for the purpose of providing a contact lens of improved oxygen permeability and improved comfort.

With reference to claims 44-51, Lieberman and Kunzler et al disclose and teach as is set forth above and Kunzler further teaches that the silicone hydrogel contact lens provides improved comfort i.e. a lens that can provide extended wear (to the extent this

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term is understood) and further that the silicone hydrogel contact lens is swelled with water for the purpose of providing a contact lens of improved oxygen permeability and comfort (column 1, lines 10-37). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Lieberman in view of Kunzler as further providing extended wear and that swells with water since Kunzler et al further teaches of these features for the purpose of providing a contact lens of improved oxygen permeability and comfort.

Claims 11-15 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsley patent number 5,020,898 in view of Kunzler et al patent number 6,921,802.

With respect to claims 11-12 and 15, Townsley discloses the limitations therein including the following: a cast-molded contact lens (abstract, column 6, lines 22-27) comprising a lens body including a hydrophilic soft contact lens material (column 1, lines 42-52); the lens body having a toric surface (column 2, lines 35-44); a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness (column 2, lines 35-68 i.e. the thickness tapering in a smooth curve and Figures 2-4 which discloses the thickness varying radially); the varied surface topography facilitating lens comfort (column 2, lines 35-44); the lens structured to correct an astigmatism of the eye (abstract); and the varied surface topography provided on the anterior surface of the lens (column 2, line 45 to column 3, line 12). Townsley discloses as is set forth above including that the lens material can be a soft

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hydrophilic material (column 1, lines 42-52) but does not specifically disclose this material as a silicone hydrogel or hydrophilic silicone polymer.

Kunzler et al teaches that contact lenses made of soft hydrophilic or hydrogel material (column 1, lines 10-37, column 3, line 60) can specifically be formed by cast-molding of silicone hydrogel or hydrophilic silicone polymer for the purpose of making a contact lens of improved oxygen permeability and improved comfort (column 1, lines 10-37, column 3, line 60, column 8, lines 22-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the soft hydrophilic or hydrogel contact lens of Townsley as being specifically made by cast-molding a silicone hydrogel or hydrophilic silicone polymer since Kunzler et al teaches that contact lenses made of soft hydrophilic or hydrogel material can specifically be made by cast-molding silicone hydrogel or hydrophilic silicone polymer for the purpose of providing a contact lens of improved oxygen permeability and improved comfort.

With reference to claims 13-14, Townsley and Kunzler et al disclose and teach as is set forth above and Kunzler further teaches that the hydrophilic silicone polymer can further include at least one monomer of siloxane for the purpose of providing a contact lens of improved oxygen permeability and comfort (column 1, lines 10-37, column 3, line 65 to column 4, line 34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the hydrophilic silicone polymer as including at least one monomer of siloxane since Kunzler et al further teaches of this feature for the purpose of providing a contact lens of improved oxygen permeability and improved comfort.

With reference to claims 46-47, Townsley and Kunzler et al disclose and teach as is set forth above and Kunzler further teaches that the silicone hydrogel contact lens provides improved comfort i.e. a lens that can provide extended wear (to the extent this term is understood) and further that the silicone hydrogel contact lens is swelled with water for the purpose of providing a contact lens of improved oxygen permeability and comfort (column 1, lines 10-37). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Townsley in view of Kunzler as further providing extended wear and that swells with water since Kunzler et al further teaches of these features for the purpose of providing a contact lens of improved oxygen permeability and comfort.

Response to Arguments

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new grounds of rejection set forth above.

Allowable Subject Matter

Claims 10, 22, 30, and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with respect to claims 10, 22, 30 and 43, none of the prior art either alone or in combination disclose or teach of the claimed

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contact lens having the specific lens structure and specifically including, as the distinguishing feature in combination with the other limitations, the claimed lens body configured to correct or reduce a wavefront aberration of the eye.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
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February 21, 2006